



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jacques H. Helot, et al.

Confirmation No.: 1876

Application No.: 09/439,626

Examiner: Michael A. Cuff

Filing Date: Nov. 12, 1999

Group Art Unit: 3627

Title: A SYSTEM AND METHOD FOR ORDERING CONSUMER ITEMS IN ELECTRONIC
COMMERCE

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TRANSMITTAL OF APPEAL BRIEF

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Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed
on 10/27/2004.

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(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)
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() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is
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Respectfully submitted,

Jacques H. Helot, et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Jacques H. Helot, et al.
Serial No.: 09/439,626
Filing Date: November 12, 1999
Group Art Unit: 3627
Examiner: Michael A. Cuff
Title: A System and Method for Ordering
Consumer Items in Electronic Commerce

MAIL STOP: APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed September 9, 2004 finally rejecting Claims 29-48. Applicant filed a Notice of Appeal on October 22, 2004. Applicant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$340.00.

REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Company as indicated by an assignment from the inventor recorded on March 6, 2000 in the Assignment Records of the United States Patent and Trademark Office at Reel 010665, Frame 0815. The present application was subsequently assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from Hewlett-Packard Company recorded on September 30, 2003 in the Assignment Records of the United States Patent and Trademark Office at Reel 014061, Frame 0492.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 29-48 stand rejected pursuant to a Final Office Action mailed September 9, 2004. Claims 29-48 are presented for appeal.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF INVENTION

Independent Claim 29

Embodiments of the present invention as defined by independent Claim 29 are directed toward a computer-implemented ordering system (100,300) comprising an interface (315) adapted to provide a representation of a consumer item and an option associated with the consumer item (page 7, lines 5-12, page 11, lines 2-30, page 12, lines 1-9, figures 1-3). Such embodiments also comprise a presentation module (320) adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option (page 11, lines 2-30, page 12, lines 1-9, page 14, lines 15-24, figures 1-3).

Independent Claim 36

Embodiments of the present invention as defined by independent Claim 36 are directed toward a computer-implemented ordering method comprising providing a representation of a consumer item and an option associated with the consumer item and providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option (page 11, lines 2-30, page 12, lines 1-9, page 14, lines 15-24, figures 1-4).

Independent Claim 42

Embodiments of the present invention as defined by independent Claim 42 are directed toward a computer-implemented ordering system (100,300) comprising a means (315) for providing a representation of a consumer item and an option associated with the consumer item and a means (320) for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option (page 11, lines 2-30, page 12, lines 1-9, page 14, lines 15-24, figures 1-4).

GROUND OF REJECTION

1. Claims 29-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,052,669 issued to Smith et al. (hereinafter “*Smith*”) in view of U.S. Patent No. 6,353,824 issued to Boguraev et al. (hereinafter “*Boguraev*”).

ARGUMENT

A. Standard

35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness under 35 U.S.C § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

B. Argument – Claims 29-48

Claims 29-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Smith* in view of *Boguraev*. Of these claims, claims 29, 36 and 42 are independent. Applicant respectfully submits that each independent claim is patentable over *Smith* and *Boguraev*, alone or in combination, and thus remaining claims 30-35, 37-41 and 43-48 which depend respectively from the independent claims 29, 36 and 42 are also patentable.

Embodiments of the present invention generally involve a computerized system and method for enabling a user to view, modify and/or order a consumer item (page 5, lines 22-28). For example, the consumer item (e.g., in the form of a base item and any available options for the base item) is presented or displayed to a user via a graphical user interface (GUI) or other type of interface enabling the user to interact with the system (page 11, lines 11-17). Embodiments of the present invention also enable the user to update the displayed consumer item with a desired option in real-time by clicklessly positioning a cursor over an icon corresponding to the option (page 14, lines 13-24). For example, the present invention enables the consumer item to be updated with a desired option by positioning a cursor of a pointing device over the desired option without having to “click” on the desired option (Page 11, lines 15-24). Accordingly, independent Claim 29 recites “a presentation module adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option,” independent Claim 36 recites “providing a real-time preview representation of the consumer item updated with the option in response to a

user clicklessly positioning a cursor over an icon corresponding to the option,” and independent Claim 42 recites “means for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.”

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. For example, Applicants respectfully submit that there is no motivation or suggestion to combine reference teachings as proposed by the Examiner, nor is there any reasonable expectation of success based on the proposed combination of references. Further, the proposed combination of references teach away from the invention as claimed by Applicants.

Smith discloses a method and system for configuring office furniture having a graphical user interface for presenting a user with various selectable options (*Smith*, Abstract, lines 1-3, col. 3, lines 60-63). The Examiner apparently cites *Boguraev* for the purpose of disclosing an updated presentation in response to rolling a mouse over an icon (Final Office Action, page 3). The Examiner then states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of *Boguraev* with the invention of *Smith* to update the presentation when a user clicklessly positions a cursor over [an icon] because it is more efficient than requiring a user to click on an icon” (Final Office Action, page 3). Applicants respectfully disagree.

Smith discloses a planning guide which “consists of a series of forms which are graphically displayed on the screen, each form having a number of options. Once the user selects a particular option, a screen for that option is displayed with questions about the various sub-options” (*Smith*, col. 8, lines 12-16). *Smith* also discloses that, “[f]or example, in order to determine the user’s storage requirements, the user selects a storage requirements option and is presented with a storage requirements screen” (*Smith*, col. 8, lines 16-19). Figure 8 of *Smith* illustrates a typical workstation according to *Smith* (col. 9, lines 29-34), and Figures 10-12 of *Smith* depict configuration screens for modifying the typical workstation (col. 9, lines 54-57, col. 10, lines 22-24, lines 29-31, col. 11, lines 8-14). As clearly illustrated in Figures 8

and 10-12 of *Smith*, the visual display of the typical workstation of *Smith* is behind or otherwise covered by the configuration screens of *Smith*. Therefore, there is no suggestion or motivation to combine reference teachings as proposed by the Examiner because the visual display of the typical workstation of *Smith* is behind or otherwise covered by the configuration screens of *Smith* from which modifications to the workstation would be selected. Thus, there is no suggestion or motivation to modify *Smith* to provide a preview representation as suggested by the Examiner because, during modification of an item by a user utilizing the *Smith* planning guide, the item being modified is not in view of the user. Clearly, the Examiner is using hindsight reconstruction to piece together the teachings of the prior art to arrive at Applicants' claimed invention, which is improper under the M.P.E.P. and the courts.

Additionally, even if there was a motivation or suggestion to combine reference teachings, which Applicants submit is lacking, there is no reasonable expectation of success based on the proposed combination of references. For example, combining reference teachings as suggested by the Examiner would not provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option as recited generally by independent Claims 29, 36 and 42 because the visual display of the typical workstation of *Smith* is behind or otherwise covered by the configuration screens of *Smith*, thereby preventing a presentation of any visual update to the workstation to the user of *Smith*. Therefore, even if the teachings of *Smith* and *Boguraev* were combined, a user would not be provided with a preview representation of the consumer item by clicklessly positioning a cursor over an icon on a configuration screen of *Smith* because the modified consumer item would be behind or otherwise covered by the configuration screen of *Smith*. Therefore, there is no reasonable expectation of success to combine reference teachings as proposed by the Examiner.

Moreover, *Smith* teaches away from the proposed combination of references as suggested by the Examiner because *Smith* clearly discloses that the item being modified in *Smith* is covered or otherwise hidden from view during such

modification. Therefore, *Smith* clearly teaches away from providing a user with a preview presentation of the item being modified.

In responding to Applicants' arguments presented in a Response (filed May 20, 2004) to an Office Action (mailed February 20, 2004), the Examiner states that *Smith* discloses a "windows" environment and, therefore, a window can be moved (Final Office Action, page 4). Applicants assume that the Examiner is referring to the configuration screen of *Smith* as a "window." Applicants respectfully disagree. First, referring to figure 10 of *Smith*, for example, the configuration screen of *Smith* illustrated in figure 10 does not appear to be a "window" as suggested by the Examiner. Thus, there is no disclosure or suggestion in *Smith* indicating the movability of the configuration screen of *Smith*. Second, *Smith* appears to disclose that in response to selecting one of the options available on a particular configuration screen, the selected option is displayed on the configuration screen at the location indicated at 182 (*Smith*, figures 8, 10, 11 and 12, column 9, lines 20-23). However, the base consumer item to which the option is to be applied in *Smith* remains behind the configuration screen of *Smith* and hidden from view by the user of *Smith*. Thus, even if the configuration screen of *Smith* is considered a "window" as suggested by the Examiner, which Applicants respectfully disagree, there appears to be no reason to move the configuration screen of *Smith* as suggested by the Examiner because the selected option is displayed on the configuration screen. Lastly, the configuration screen of *Smith* appears to require positive action by a user of *Smith* to update the base consumer item (which is behind the configuration screen of *Smith*) with the option as indicated by the menu on the configuration screen which contains "FIND," "INSERT," "REPLACE" and "CANCEL" thereon (*Smith*, figures 7, 10, 12 and 14). Therefore, *Smith* apparently requires the user to positively click on or select the "INSERT" menu option on the configuration screen to apply the option. Accordingly, *Smith* teaches away from the Examiner's reasoning.

Further, as recited above, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d at 1349. The Final Office Action failed to cite any

apparent disadvantage of *Smith* which would prompt the combination of select teachings of *Boguraev* therewith. For example, in the Final Office Action, the Examiner states as a basis for the proposed combination that clicklessly positioning a cursor over an item “is more efficient than requiring a user to click on an icon” (Final Office Action, page 3). However, as discussed above, providing a clickless update in *Smith* as proposed by the Examiner would not be viewable by a user of *Smith* because the modified consumer item would be behind or otherwise covered by the configuration screen of *Smith*. Therefore, the Examiner’s reasoning provides no “advantage” to the *Smith* system. Clearly, there is no suggestion or motivation to combine reference teachings as proposed by the Examiner.

Thus, for at least the reasons discussed above, independent claims 29, 36 and 42 are patentable over *Smith* and *Boguraev*. Accordingly, Applicants respectfully submit that the rejection of claims 29, 36 and 42 was improper and that claims 29, 36 and 42, and claims 30-35, 37-41 and 43-48 which respectively depend from claims 29, 36 and 42, are in condition for allowance.

CONCLUSION

Applicants have demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

Date: 12-16-04


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CLAIMS APPENDIX

29. A computer-implemented ordering system, comprising:
an interface adapted to provide a representation of a consumer item and an option associated with the consumer item; and

a presentation module adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.

30. The system of Claim 29, wherein the presentation module is adapted to update a stored representation of the consumer item updated with the option in response to the user clicking on the icon.

31. The system of Claim 29, wherein the option associated with the consumer item depends at least in part on a previously selected option.

32. The system of Claim 29, wherein the presentation module is adapted to provide attribute data associated with the consumer item.

33. The system of Claim 29, wherein the presentation model is adapted to automatically update in real-time attribute data associated with the preview representation of the consumer item updated with the option.

34. The system of Claim 29, wherein the presentation module is adapted to prevent selection of the option by a user in response to a previously selected option by the user.

35. The system of Claim 29, wherein the presentation module is adapted to provide an audio preview representation of the consumer item updated with the option.

36. A computer-implemented ordering method, comprising:
providing a representation of a consumer item and an option associated with the consumer item; and

providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.

37. The method of Claim 36, further comprising updating a stored representation of the consumer item updated with the option in response to the user clicking on the icon.

38. The method of Claim 36, further comprising providing attribute data associated with the consumer item.

39. The method of Claim 36, further comprising automatically updating in real-time attribute data associated with the preview representation of the consumer item updated with the option.

40. The method of Claim 36, wherein providing a representation comprises providing an audio preview representation of the consumer item updated with the option.

41. The method of Claim 36, further comprising preventing selection of the option by a user in response to a previously selected option by the user.

42. A computer-implemented ordering system, comprising:
means for providing a representation of a consumer item and an option associated with the consumer item; and

means for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.

43. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for updating a stored representation of the consumer item updated with the option in response to the user clicking on the icon.

44. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for providing attribute data associated with the consumer item.

45. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for automatically updating in real-time attribute data associated with the preview representation of the consumer item updated with the option.

46. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for preventing selection of the option by a user in response to a previously selected option by the user.

47. The system of Claim 42, wherein the means for providing a real-time preview representation comprises means for providing an audio preview representation of the consumer item updated with the option.

48. The system of Claim 42, further comprising means for acquiring statistical data associated with the consumer item.